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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,704	09/12/2003	Minas Theodore Coroneo	Q77494	7676
23373	7590	10/05/2005		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER GHERBI, SUZETTE JAIME J	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/660,704	CORONEO, MINAS THEODORE	
	Examiner	Art Unit	
	Suzette J. Gherbi	3738	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 June 2005.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 and 19 is/are allowed.
- 6) ☒ Claim(s) 1-8, 12-16 and 18 is/are rejected.
- 7) ☒ Claim(s) 9-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 and 01 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/1/05</u>  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Applicant's amendment dated 6/1/05 has been received in application serial number 10/660,704. All comments have been taken into careful consideration.

#### ***Drawings***

2. In response to applicant's comments with regards to figures 6A-6C the drawing objection has been withdrawn. New figure 7 has been accepted.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 12-15, 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Portney 2003/00199976. Portney discloses the invention as claimed comprising: An IOL with an anterior and posterior surfaces [0024] defining a central visually transparent lens optic extending from the anterior to the posterior surface; and a

peripheral portion outside the central lens optic, wherein the optical properties of the peripheral portion are selected such that oblique incident light focusing (see [0044]) on the peripheral portion is diminished or refracted laterally or anteriorly as opposed to posteriorly; wherein the IOL is foldable; wherein the IOL has haptics and is used for the treatment of cataracts[0007]. See sections [0011; 0024-0027; 0030; 0044; 0052; 0062-0063; 0065]).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portney in view of Brady et al. 2003/0144733. Portney has been disclosed above however Portney does not specify that the peripheral portion utilizes light absorbing material. Brady et al. teaches an IOL that features the use of light absorbing material/color (see [0123]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to take the invention of Portney and utilize the light absorbing materials/colors as taught by Brady et al. because both IOLS function is to reduce/diminish glare and both IOLS contain peripheral portions.

7. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portney in view of Achatz et al. 4,813,955. Portney has been disclosed however Portney does not specify that the oblique incident light is refracted on the peripheral portion forward the nasal retina in the eye. Achatz et al. teaches an IOL in which the incident is adjusted near the nasal portion (see col.2, lines 24-39. It would have been obvious to one having ordinary skill in the art at the time the invention was made to made the lens of Portney such that the oblique incident light is directed forward of the nasal retina in the eye in order to divert it away from the retina into a location that is not effected.

***Allowable Subject Matter***

8. Claim 9-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 17 and 19 are allowed.

***Response to Arguments***

10. Applicant's arguments filed 6/1/05 have been fully considered and with regards to claims 10, 17 and 19 are persuasive however with regards to the remaining pending claims the arguments are not persuasive.

11. Applicant contends with regards to claims 1-4 and 12-18 that Portney does not disclose the invention quoting "*The lens of Portney has a peripheral transition zone that separates central and peripheral "imaging zones" of the lens. Accordingly, the peripheral zone of the Portney lens, which is also an imaging zone is still part of the central lens optic.*" The examiners response is that Portney does disclose the invention as currently claimed. Portney does indeed have a peripheral portion (as admitted by the applicant) outside of the central lens optic. Applicant does not claim separate and/or discrete peripheral portions even though they seem to be arguing this feature. Whether or not they are imaging zones as argued is moot because they are still "zones" and a zone is defined as: An area or a region distinguished from adjacent parts by a distinctive feature or characteristic. Given this definition the outer zone (which equates to the peripheral portion as claimed) of Portney (for example element 88) is peripheral to portion/zone (90).

12. Applicant further contends *that Portney's lens does not refract oblique incident of light and that it is still possible for the refracted light to travel in a posterior direction and*

*then states that Portney does not give an indication as to how Peripheral the light source actually is.*

13. The examiner points out that in claims 1 an "or" option is provided (*...such that oblique incident light focusing on said peripheral portion is diminished OR refracted laterally OR anteriorly as opposed to posteriorly*). Applicant seems to only argue one aspect of three choices in the claim. As admitted by applicant Portney discloses in claim 16 "*....curvature shaped to minimize indirect glare created by a peripherally located source of light impinging through the optic on substantially width of said transition zone in an individual's eye.*" This meets the first of the three options given in the claim for that the oblique incident of light focusing on the peripheral portion is diminished. Further section [0052] describes the fact that "*...the transition zone which is shaped for refraction incident light out of the transition zone in a manner minimizing indirect glare in the eye of individual in which the optic is implanted, also shown in broken lines is a projected peripheral edge...*"

14. Applicant believes that the 103 rejection of claims 5-7 of Portney and Brady is improper because "*...incident light is not absorbed or prevented from traveling posteriorly through the lens, rather, it is merely refracted over the pigmented peripheral edge of the lens..*". In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case The examiner has utilized the Brady reference not for the functionality i.e. the focusing mechanisms of the lens but to teach that absorbing materials have been utilized in the IOL art and are not a novelty. The motivation is derived from the fact that Portney's object is to reduce glare and light absorbing materials have been known to help to reduce glare.

15. Further applicant argues the combination of claims 8 and 19 of Portney in view of Achatz et al. and states that it is not obvious to combine the references. Once again as stated above the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The motivation for these claims is derived from the fact that both Portney and Achatz et al. teaches IOL's with segmented zones. By providing a zone closer to the wear's nose as taught by Achatz et al. and the curvatures as taught by Portney it is possible to refract oblique incidents of light to the forward portion of the nasal retina in the eye

16. It has also been observed by the examiner that while applicant has provided product claims they mainly argue the functionality of the device. The office action above is deemed proper because it teaches the structure as claimed and is capable of performing the functions as claimed.



***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzette J. Jackson whose work schedule is Monday-Friday 9-6:30 off every other Friday and whose telephone number is 571-272-4751.

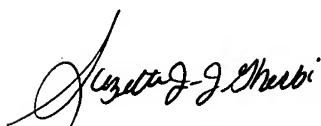
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

18. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306.

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19. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

A handwritten signature in cursive script, appearing to read "Suzette J-J Gherbi".

Suzette J-J Gherbi

19 August 2005